



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,743	08/15/2000	Miyuki Fujita	1272.C0421	1898

5514 7590 10/14/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

NOLAN JR, CHARLES H

ART UNIT PAPER NUMBER

2854

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/639,743

Applicant(s)

FUJITA ET AL.

Examiner

Charles H Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 and 41-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Claims 1-11 and 25-40 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the search for the apparatus and the method/computer readable medium would be the same and that some of the claims could not be practiced in a cd recorder. This is not found persuasive because the MPEP section referred to in the last Office Action recognizes that method and apparatus claims may be properly restricted if the method invention may be practiced by a materially different apparatus. It is Applicant's belief that some of the claims cannot be practiced by a cd recorder. Therefore, Applicant admits that some of the claims may be practiced by a cd recorder. Thus, the restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4,7-11 and 25-40 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hayashi et al. (6,375,297).

4. With respect to Claim 1, Hayashi teaches the forming step in his claim 3 and figure 15, the entering step in his claim 1 and the storing step in his claim 3(reception means). With respect to Claim 2, Hayashi teaches the columns of print elements shifted less than the amount at which the print elements are arranged in figure 15. With respect to Claim 3, Hayashi teaches the nonvolatile memory(storage means) in his claim 3. With respect to Claims 4,31,35,39, Hayashi teaches subscan feeding higher density in figure 8. With respect to Claim 7, Hayashi teaches the inkjet printer in the Abstract. With respect to Claims 8,10,26,34,38, Hayashi teaches the speed and distance adjustments in his claim 2(wherein clause) based on temperature in his claim 5. With respect to Claims 9,11,32,36,40, Hayashi teaches the thermal inkjet printer in column 2, lines 36-47. With respect to Claim 25, note the rejection of Claim 1 above and Hayashi's teaching of a storage medium in his claim 22. With respect to Claim 27, Hayashi teaches the first and second memory means in his claim 8-9. With respect to Claim 28, Hayashi teaches the distance(gap) on the front page diagram. With respect to Claim 29, Hayashi teaches the ejection speed in his claim 2. With respect to Claim 30, Hayashi teaches the nonvolatile memory 25 on the front-page diagram. With respect to Claims 33,37, note the rejection of Claim 1 and that Hayashi teaches the temperature detection 28 on the front-page diagram. Applicant **cannot rely upon the foreign priority papers to overcome** this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. **An unavoidably necessary part of the next response to this Office Action is a sworn English translation of the foreign priority papers.**

5. Claims 1-4,7,9 and 25 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by EP 0 895 869 A2 to Shimada et al.

Allowable Subject Matter

6. Claims 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

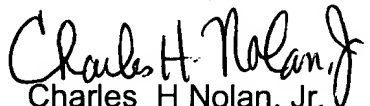
7. The following is a statement of reasons for the indication of allowable subject matter: The total combination of Claim 5 or 6 is not taught and/or rendered obvious by the prior art of record..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 703-308-0961. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

CHN


Charles H Nolan, Jr.
Examiner
Art Unit 2854